

Application Number 10/790,965

Response to Office Action mailed July 28, 2008

REMARKS

This Response is responsive to the Office Action dated July 28, 2008. Applicants have not amended any of the claims. Claims 30-35 and 42-52 remain pending.

In the Office Action, the Examiner rejected different claims under several different rationales. Each of the rejections is addressed below.

Rejections based on Suzuki (US 4,947,384)

In the Office Action, the Examiner rejected claims 42-46 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Suzuki (US 4,947,384). The Examiner also rejected claims 30-35 under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Sasaki et al. (US 5,325,353).

In these rejections, the Examiner relied on a typographical error in Suzuki, and has failed to demonstrate that Suzuki actually enables a track pitch of 1.6 microinch and groove dimensions of 0.8 microinch, which the Examiner relies upon to reject the track pitch and groove dimension features of Applicants' claims. The Examiner's position is incorrect.

Applicants have previously demonstrated that Suzuki has a typographical error, which the Examiner relied upon in the rejections. Applicants have further demonstrated that Suzuki fails to enable the mis-translated dimensions that the Examiner relies upon in the rejections.

The Examiner has responded in the current Office Action by indicating that Applicants failed to provide any declarations that substantiate Applicants' assertions regarding the typographical error and Suzuki's failure to enable the mis-translated dimensions.

Filed herewith is a declaration under 37 C.F.R. 1.132 from an inventor of the current application (Jathan Edwards). The declaration substantiates Applicants' previous assertions regarding Suzuki, and is sufficient to overcome all pending rejections based on Suzuki.

In view of the previous arguments regarding Suzuki, and the attached declaration that substantiates Applicants' previous assertions, Applicants have demonstrated and substantiated that the teaching of Suzuki is inadequate to enable a person of ordinary skill in the art to achieve the cited dimensions (in microinches). In addition, Applicants have further demonstrated that the entire discussion of microinches in Suzuki is clearly a typographical translation error relative to the Japanese priority document of Suzuki. A person of ordinary skill would interpret such

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typographical translation errors in Suzuki as suggesting track pitches at 1.6 micrometers, not 1.6 microinches.

The non-enabling disclosure in Suzuki of dimensions that are clearly the result of a translation error is *per se* insufficient to support a rejection under 35 U.S.C. 102 or 35 U.S.C. 103. The rejections based on Suzuki must be withdrawn.

Obviousness rejections based on Sandstrom (US 6,002,663)

In the Office Action, the Examiner rejected claims 30-35 and 42-52 under 35 U.S.C. 103 as being unpatentable over Sasaki (US 5,325,353) in view of Sandstrom (US 6,022,663). The Examiner also rejected claims 30-35 and 42-52 under 35 U.S.C. 103 as being unpatentable over Sandstrom in view of Sasaki. The Examiner also rejected claims 42 and 46 (in the alternative) under 35 U.S.C. 103 as being obvious over Sandstrom.¹ The Examiner also rejected claims 43-45 under 35 U.S.C. 103 as being obvious over Sandstrom in view of Sasaki.

Applicants respectfully traverse all pending obviousness rejections that rely upon Sandstrom on the basis that Sandstrom fails to qualify as prior art under 35 U.S.C. 103. In particular, at the time of the invention, the subject matter of Sandstrom and the subject matter of all pending claims of this application were assigned and/or subject to assignment to Imation Corp. For this reason, Sandstrom is disqualified as prior art under 35 U.S.C. 103(c) for use in obviousness rejections.

The assignments recorded in Sandstrom and in the present application substantiate these assertions. The assignment of Sandstrom to Imation Corp. is recorded in the USPTO at reel/frame 008584/0886. The assignment of the present application to Imation Corp. is recorded in the USPTO at reel/frame 015040/0612. These two recorded assignments demonstrate that the present application and Sandstrom were assigned and/or subject to assignment to Imation Corp. at the time of the invention.

All pending rejections under 35 U.S.C. 103 that rely upon Sandstrom must be withdrawn.

¹ This rejection was in the alternative to a rejection under 35 USC 102(e) that claims 42 and 46 are anticipated by Sandstrom. The anticipation rejections of claims 42 and 46 are addressed below.

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Anticipation rejections based on Sandstrom (US 6,002,663)

In the Office Action, the Examiner rejected claims 42 and 46 under 35 U.S.C. 102(e) as being anticipated by Sandstrom. The Examiner appears to be correct that Sandstrom qualifies as prior art under 35 U.S.C. 102(e), although this prior art is disqualified as being prior art under 35 U.S.C. 103.

For the rejections of claims 42 and 46 under 35 U.S.C. 102(e) as being anticipated by Sandstrom, the Examiner provided argument that various features of claims 42 and 46 are "method steps" that are not given patentable consideration in a patentability analysis. Applicant generally disagrees with the Examiner's assertions.

However, even if the Examiner were correct that claims 42 and 46 recite "method steps" that should not be given patentable consideration, claims 42 and 46 structurally recite a second generation stamper. This is the most basic requirement of independent claim 42.

Therefore, regardless of how this second-generation stamper is created, the fact that the stamper is a second-generation stamper is a structural aspect of claims 42 and 46. Second-generation stampers differ from first-generation stampers, for example, in terms of the orientation of lands and grooves on the stamper surface.

Sandstrom cannot and does not anticipate claims 42 or 46 for at least the reason that Sandstrom fails to disclose any type of second-generation stamper.

CONCLUSION

All claims in this application are in condition for allowance. Applicants respectfully request reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 09-0069. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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By:

11/7/8
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